In the Office Action under reply, claims 1-3, all the claims remaining in this application, were ***provisionally*** rejected on the ground of obviousness-type double patenting in view of claims 1-8 of copending application 10/786,649. This is the only rejection in the instant application. The Examiner contends, "Regarding claim 1 of the 10/786927 application [the present application], these claims are directed toward the same subject matter as claim 1 of the 10/786849." There is no element-to-element comparison of claim 1 of the present application to claim 1 of application 10/786,849, nor is there any explanation of why claim 1 of the present application is obvious in view of claim 1 of application 10/786,849.

It should be pointed out, the present application and application 10/786,849 were filed in the Office on the same day. Both applications claim priority to Japanese applications that were filed in Japan on the same day.

The purpose of rejecting claims in commonly owned applications of different inventive entities, as is the case here, is to prevent an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See MPEP §706.02(l)(3):

> A rejection based on a pending application would be a provisional rejection. The practice of rejecting claims on the ground of double patenting in commonly owned applications of different inventive entities is in accordance with existing case law and prevents an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See MPEP § 804 for guidance on double patenting issues. In accordance with established patent law doctrines, double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the existing provisions of 37 CFR 1.321, the terminal portion of the term of the later patent and including in the disclaimer a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, thereby eliminating the problem of extending patent life.

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Since both applications were filed on the same day, the possibility of having two patents issue with different expiration dates can be avoided simply by timely prosecution of both applications, with no unnecessary delays, thereby obviating the need for a terminal disclaimer.

Attention is directed to MPEP §802 B, regarding double patenting rejections between copending applications:

> The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in >at least< one of the applications. **
>
> If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

In the present case, the only rejection remaining in the present application is the "provisional" double patenting rejection. Consistent with the provisions of the MPEP, the Examiner should withdraw the obviousness double-patenting rejection in the present case, thereby permitting this application to issue without the need of a terminal disclaimer. But, since both applications were filed on the same day, to continue the provisional double patenting rejection requires the Examiner to "determine which application claims the base invention and which application claims the improvement." This determination has not been made; and as will be discussed below, the claims of the present application are directed to different features than are the claims in application 10/786,849. This is not a simple case of one application containing claims

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directed to the "base invention" and the other containing claims directed to the "improvement." Thus, the provisional double-patenting rejection in this application is improper and should be withdrawn.

Still further, as demonstrated by the claim comparison below, claim 1 of the present application recites limitations that are neither found in nor obvious from the limitations recited in claim 1 of application 10/786,849. It is respectfully submitted, therefore, the situation presented here does not admit of one-way or two-way obviousness. Nor are the claims of one application directed to the base invention and the claims of the other application directed to the improvement. The comparison of the "index file production means setting," as recited in claim 1 of the respective applications is as follows:

Claim Comparison Between 10/786,927 and 10/786,849

Claim 1 of 10/786,927	Claim 1 of 10/786,849
said index file production means setting, in the management information of each of the slots of the group of property, at least a slot number for specifying the corresponding slot of the different group and valid/invalid information representative of whether each of the slot of the group of property and the corresponding slot of the different group is valid or invalid;	said index file production means setting, in the management information of each of the slots of the group of property, valid/invalid information representative of whether the slot is valid or invalid, an extension slot number pointing to an extension slot succeeding the slot, presence/absence information representative of whether a corresponding slot of the different group to which the extract information of the file relating to the slot is allocated is present or absent, a slot number pointing to the corresponding slot of the different group, and extension information representative of whether or not the corresponding slot of the different group is an extension slot;
said index file production means setting, in a header of the group of property, a last valid slot number for specifying a last one of those of the slots of the group of the property which are set to valid with the valid/invalid information.	a combination of the slots to which the extract information of the one file or the folder is allocated with the extension slot number, presence/absence information, slot number, and extension information being indicated by the group of property.

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The underlined portions of the respective claims find no correspondence in the other claim. The Examiner has not explained why, in his view, the underlined portions of claim 1 of 10/786,927 are obvious in view of claim 1 of 10/786,849; nor why the underlined portions of claim 1 of 10/786,849 are obvious in view of claim 1 of 10/786,927. There is no one-way obviousness of the claims.

Applicants' representative will consider the filing of a terminal disclaimer in the present application in the event the Examiner maintains and satisfactorily explains the basis for his double-patenting rejection and if application 10/786,849 issues as a patent before the issuance of a patent on the present application.

In view of the foregoing, it is respectfully requested that the double-patenting rejection be withdrawn; and since there are no other rejections of record, this application should proceed to issuance. Reconsideration and allowance of this application are solicited.

Respectfully submitted,
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